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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,810	02/09/2004	Thomas Hofbrucker	DT-6756	9681

30377 7590 10/31/2005

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EXAMINER
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DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/775,810	<b>Applicant(s)</b> HOFBRUCKER ET AL.	
	<b>Examiner</b> Paul Durand	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2005 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olvera et al (US 5,897,045) in view of Lin (US 6,779,697).

In regard to claim 9, Olvera discloses the invention substantially as claimed including a tool 10, pipe arrangement comprised of feed tube 130, fall pipe comprised of lower passage 172 of block 170, guide pipe in the form of upper and lower tubes 30 and 40, having an outlet (no number, but generally by 52 in figure 1b), head piece 50, arranged at the outlet, with holding device 54, for receiving fasteners 4 (see Fig.1 and C5,L20 – C6,L37). What Olvera does not disclose is the ability to rotate a headpiece

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relative to the rest of the device. However, Lin teaches that it is old and well known in the art to provide a rotating head and guide member in the form of barrel 6, and rotating relative to a pipe in the form of sleeve 4 and the rest of the tool for the purpose of operating the tool around an obstacle, which can in the broadest sense, encompass a profile of a work piece (see Fig.2 and C2,L16 – C3,L29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Olvera with the rotating means as taught by Lin for the purpose of operating the tool around an obstacle.

In regard to claims 2,3 and 7, Olvera discloses the invention substantially as claimed except the rotating headpiece, However, Lin teaches that it is old and well known in the art to provide a rotating head, which rotates to at least two rotating positions of substantially 90° and a locking device comprised of a setscrew 530 for the purpose of operating the tool around an obstacle (see Figs. 2 and 9). ). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Olvera with the rotating means as taught by Lin for the purpose of operating the tool around an obstacle.

In regard to claims 4-6, the modified invention of Olvera discloses the invention substantially as claimed except for the use of a locking device. However, Lin teaches that it is old and well known in the art to provide a locking device comprised of hole 42 in a head piece 4, locking body comprised of a ball bearing 52, pressed against rotating head and guide member 6, engaging two receptacles 610 and biased by coil springs 51 for the purpose of operating the tool around an obstacle (see Figs. 2,7,9,10 and C2,L16

– C3,L29). Furthermore, while the modified invention uses a coil spring, the examiner takes Official Notice that it would have been an obvious matter of design choice to use a leaf spring in lieu of a coil spring for the purpose of holding a locking member in place.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Olvera with the rotating means as taught by Lin for the purpose of operating the tool around an obstacle.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olvera et al and Lin in view of Caringella et al (US 6,761,299).

The modified invention of Olvera discloses the invention substantially as claimed except for a locking pin to retain the head member on the tool. However, Caringella teaches that it is old and well known in the art to provide a pin in the form of screw 182, which attaches to key 184 and into hole 188 for the purpose of retaining a head portion on a rotating tool (see Fig.8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the modified invention of Olvera with the pin retaining means as taught by Caringella for the purpose of retaining a head portion on a rotating tool.

### ***Response to Arguments***

4. Applicant's arguments filed 9/30/2005 have been fully considered but they are not persuasive.

Applicant first argues that there is no suggestion to combine the references of Lin

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with the primary reference of Olvera. The examiner does not agree. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner asserts that there is sufficient motivation and suggestion to combine Lin with Olvera, since Lin clearly disclose the need to provide some sort of adjustability to a driving member tool allow a user to overcome obstacles on the work piece, which may be based on the tool profile.

Furthermore, if applicant is trying to advance the position that Lin and Olvera is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner asserts that the prior art in the field of the applicant's endeavor, since both references relate to the same field (i.e. fastener loading and driving). In addition, the examiner further asserts that the teaching of Lin is quite capable of being used while standing up.

Therefore, for the reasons indicated above, the rejection is deemed proper.

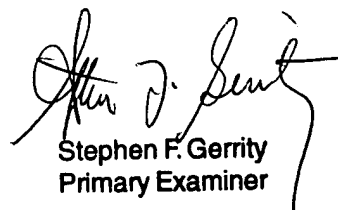
**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
October 26, 2005

  
Stephen F. Gerrity  
Primary Examiner